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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,208	10/29/2003	Jay R. Walton	010454D1	7298
23596 7590 12/11/2009 QUALCOMM INCORPORATED 5775 MOREHOUSE DR. SAN DIEGO, CA 92121				
EXAMINER CUMMING, WILLIAM D				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
12/11/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/696,208

Applicant(s)

WALTON ET AL.

Examiner

WILLIAM D. CUMMING

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the each and every step as stated in the claimed method of claims 1-11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 27-32 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

Software instructions or codes or programs are nonphysical things but claims 27-32 claims just nonphysical things, instructions, comprising a physical device, a processor, which is impossible.

5. Claims 27-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The subject matter of the claim **MUST** be directed to one of the four subject matter categories. If it is not, the claim is not eligible for patent protection and should be rejected under § 101, for at least this reason.

A summary of the four categories of invention, as they have been defined by the courts, are:

- i. Process – an act, or a series of acts or steps that are tied to a particular machine or apparatus or transform a particular article into a different state or thing.

ii. Machine – a concrete thing, consisting of parts, or of certain devices and combination of devices. This includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result.

iii. Manufacture – an article produced from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.

iv. Composition of matter – all compositions of two or more substances and all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders or solids, for example.

Non-limiting examples of claims that are not directed to one of the statutory categories:

i. Transitory forms of signal transmission (for example, a propagating electrical or electromagnetic signal *per se*).

ii. A naturally occurring organism.

iii. A human *per se*.

iv. A legal contractual agreement between two parties.

v. A game defined as a set of rules.

vi. A computer program *per se*.

vii. A company.

A claim that covers BOTH statutory and non-statutory embodiments (under the broadest reasonable interpretation of the claim when read in light of the specification and in view of one skilled in the art) embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter. Such claims fail the first step and should be rejected under § 101, for at least this reason. For example, a claim to a computer readable medium that can be a compact disc or a *carrier wave* covers a non-statutory embodiment and therefore should be rejected under § 101 as being directed to non-statutory subject matter.

As admitted by applicants' attorney remarks on August 10, 2009, stating that the claims are not the processor but to the instructions. Hence, these claims are claiming a computer program per se which is not patentable..

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not originally support and inadequately describe the now claimed a computer readable storage medium storing computer code in which the code indicates to the computer to recover data as stated by claims 21. The specification only supports a memory storing software code in which the code indicates to the processor or controller to recover data.

8. Claims 21-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not provide an enabling disclosure for the computer code as stated by claim 21 and the instructions to process a received signal to provide data samples, instructions to transform the data samples in the frequency domain in accordance with a particular transformation to provide transformed samples, instructions to de-spread the transformed samples with one or more sets of de-spreading coefficients to provide de-spread samples,

wherein each set of de-spreading coefficients is associated with a respective de-spreading code that corresponds to a spreading code used to spread data prior to transmission and selected from a set of available spreading codes, instructions to combine the de-spread samples for each time interval to provide a demodulated symbol representative of a transmitted OFDM symbol and instructions to decode demodulated symbols to provide decoded data as stated by 27 since these codes or instructions are not disclosed and is only known to the inventors . In computer applications, it is not unusual for the claimed invention to involve two areas of prior art or more than one technology, e.g., an appropriately programmed computer and an area of application of said computer. *White Consol. Indus.*, 214 USPQ at 821. In regard to the "skilled in the art" standard, in cases involving both the art of computer programming, and another technology, the examiner must recognize that the knowledge of persons skilled in both technologies is the appropriate criteria for determining sufficiency. See *In re Naquin*, 398 F.2d 863, 158 USPQ 317 (CCPA 1968); *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); and *White Consol. Indus. v. Vega Servo-Control, Inc.*, 214 USPQ 796, 822 (S.D.Mich. 1982), *aff'd on related grounds*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983). In a typical computer application, system components are often represented in a "block diagram" format, i.e., a group of hollow rectangles representing the elements of the system, functionally labeled, and interconnected by lines. Such block diagram computer cases may be categorized into (A) systems which include but are more comprehensive than a

computer and (B) systems wherein the block elements are totally within the confines of a computer. The first category of such block diagram cases involves systems which include a computer as well as other system hardware and/or software components. In order to meet his or her burden of establishing a reasonable basis for questioning the adequacy of such disclosure, the examiner should initiate a factual analysis of the system by focusing on each of the individual block element components. More specifically, such an inquiry should focus on the diverse functions attributed to each block element as well as the teachings in the specification as to how such a component could be implemented. Based on such an analysis, the examiner has reasonably contend that more than routine experimentation would be required by one of ordinary skill in the art to implement such a component or components, that component or components is specifically be challenged by the examiner as part of this 35 U.S.C. 112, first paragraph rejection. Additionally, the examiner has determine whether certain of the hardware or software components depicted as block elements are themselves complex assemblages which have widely differing characteristics and which must be precisely coordinated with other complex assemblages. Under such circumstances, a reasonable basis does exist for challenging such a functional block diagram form of disclosure. See *In re Ghiron*, 442 F.2d 985, 169 USPQ 723 (CCPA 1971) and *In re Brown*, *supra*. Moreover, even if the applicants has cited prior art patents or publications to demonstrate that particular block diagram hardware or software components are old, it should

not always be considered as self-evident how such components are to be interconnected to function in a disclosed complex manner. See *In re Scarbrough*, 500 F.2d 560, 566, 182 USPQ 298, 301 (CCPA 1974) and *In re Forman*, 463 F.2d 1125, 1129, 175 USPQ 12, 16 (CCPA 1972). Furthermore, in complex systems including a digital computer, a microprocessor, or a complex control unit as one of many block diagram elements, timing between various system elements may be of the essence and without a timing chart relating the timed sequences for each element, an unreasonable amount of work may be required to come up with the detailed relationships an applicant alleges that he or she has solved. See *In re Scarbrough*, 500 F.2d at 566, 182 USPQ at 302. For example, in a block diagram disclosure of a complex claimed system which includes a microprocessor and other system components controlled by the microprocessor, a mere reference to a prior art, commercially available microprocessor, without any description of the precise operations to be performed by the microprocessor, fails to disclose how such a microprocessor would be properly programmed to either perform any required calculations or to coordinate the other system components in the proper timed sequence to perform the functions disclosed and claimed. If, in such a system, a particular program is disclosed, such a program should be carefully reviewed to ensure that its scope is commensurate with the scope of the functions attributed to such a program in the claims. See *In re Brown*, 477 F.2d at 951, 177 USPQ at 695. Since, the disclosure fails to disclose any program and more than routine experimentation would be required of one

skilled in the art to generate such a program, the examiner clearly has a reasonable basis for challenging the sufficiency of such a disclosure.

9. Claims 27-32 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a well known asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 27-32 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 27-32 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed August 10, 2009. In that paper, applicant has stated the claim is not really an apparatus, a processor, but computer instructions, and this statement indicates that the invention is different from what is defined in the claim(s) because the subject of the claims is the processor, not the instructions.

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

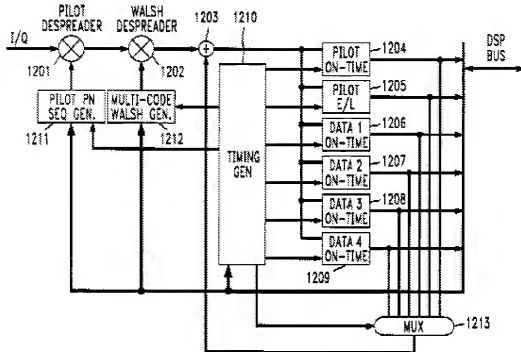
13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 1, 2, 5-8, 12, 13, 15-21, 23-25, 27, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huang, et al** in view of **Fasel** as stated in paragraph 3 of the Office action dated October 3, 2008.

FIG. 12



16. Claims 3, 4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huang** in view of **Fazel** as applied to claims above, and further in view of **Agee** as stated in paragraph 4 of the Office action dated October 3, 2008.

17. Claims 3, 4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Huang** in view of **Fazel** as applied to claims above, and further in view of **Agee** as stated in paragraph 4 of the Office action dated October 3, 2008.

Response to Arguments

18. Applicant's arguments filed August 10, 2009 have been fully considered but they are not persuasive.

Regarding applicants' attorney's remarks about the drawings, it is the examiner, not the attorney, that determines the sufficiency of the drawings. Figures 2 and 4 as describe by applicants own specification are apparatus or machines, **NOT** a process or method. Because of that **FACT** and for better and clear understanding of the claim invention, the examiner insists that the claimed method **MUST** be clearly shown.

Regarding applicants' attorney's remarks about the 35 USC 101 rejection, usually attorney's remarks help the examiner and remove rejections, not cause additional rejections as in this case. It seems the attorney is using another language other than English. Clearly the subject of this sentence is the processor, not the instructions. The claim does **NOT** say, "A processor exciting instructions for recovering data transmitted over a wireless communication channel. **the instructions comprising...**" as applicants' attorney argued. Hence, the additional rejections caused by these remarks. The examiner will continue using standard English to examine the claims.

Regarding applicants' attorney's remarks about 35 USC 112 rejections, an examining guideline to generally follow is to challenge the sufficiency of such disclosures which fail to include either the computer program itself or a reasonably detailed flowchart which delineates the sequence of operations the program must perform. There is no reasonably detailed flowchart or computer program itself in this application.

It must be emphasized that arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See *In re Budnick*, 537 F.2d at 538, 190 USPQ at 424; *In re Schulze*, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); *In re Cole*, 326 F.2d 769, 140 USPQ 230 (CCPA 1964). For example, in a case where the record consisted substantially of arguments and opinions of applicant's attorney, the court indicated that factual affidavits could have provided important evidence on the issue of enablement. See *In re Knowlton*, 500 F.2d at 572, 183 USPQ at 37; *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).<

Regarding applicants' attorney remarks about 35 USC 103, during examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (*Ex parte Akamatsu*, 22 USPQ2d, 1918; *In re Zletz*, 13 USPQ2d 1320, *In re Priest*, 199 USPQ 11). A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, *In re Samour*, 197 USPQ 1.

During patent examination, the pending claims must be "*given the broadest reasonable interpretation consistent with the specification.*" Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome "*heavy presumption*" that term takes on its ordinary meaning simply by pointing to preferred embodiment (Teleflex Inc. v. Ficosa North America Corp., CA FC, 6/21/02, 63 USPQ2d 1374). Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969).

The analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.

The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility. One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims. When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103. *KSR INTERNATIONAL CO. v. TELEFLEX INC.* 82 USPQ2d 1385.

The examiner has concluded that the invention is very obvious and not eligible for a United States Patent and no such monopoly be granted to applicants because:

(a) The invention would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improving in other situations. KSR INTERNATIONAL CO. v. TELEFLEX INC. 82 USPQ2d 1385.

(b) All the invention elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would yielded predictable results to one of ordinary skill in the art at the time of the invention. KSR INTERNATIONAL CO. v. TELEFLEX INC. 82 USPQ2d 1385.

c- The invention would have been obvious because *"a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense."* KSR INTERNATIONAL CO. v. TELEFLEX INC. 82 USPQ2d 1385.

The examiner made this Office Action non-final because of the additional rejections caused by applicants' attorney remarks. The examiner hopes the attorney to take seriously of these rejections, amend the claims to overcome the rejections, and hopefully, place this application in condition for allowance.

Conclusion

19. If applicants wish to request for an interview, an "*Applicant Initiated Interview Request*" form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed "*Applicant Initiated Interview Request*" form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM D. CUMMING whose telephone number is 571-272-7861. The examiner can normally be reached on Tuesday- Friday, 11:00am-8:00pm.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WILLIAM D CUMMING/
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